

REMARKS

This is in response to the Official Action currently outstanding with regard to the present application, which Official Action the Examiner has designated as being FINAL

Claims 1-23 were pending in this application at the time of the issuance of the currently outstanding Official Action. The foregoing Amendment proposes the amendment of Claims 1 and 18. The foregoing Amendment does not propose that any claims be added, canceled or withdrawn. Accordingly, in the event that the Examiner grants the entry of the foregoing amendment, Claims 1-25 as hereinabove amended will constitute the Claims under active prosecution in this application.

More particularly, in the currently outstanding Official Action the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and confirmed the receipt of the required copies of the priority documents by the United States Patent and Trademark Office;
2. Accepted the drawings as filed with this application on 4 December 2003;
3. Acknowledged his consideration of the Information Disclosure Statement filed in this application on 4 December 2003 by providing the Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed to confirm the consideration of the art listed therein;
4. Withdrawn his previous rejection of Claims 18-23 under 35 USC §112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps in view of Applicants' previous Amendment;
5. Withdrawn his previous rejection of Claim 19 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in view of Applicants' previous Amendment;

6. Rejected Claims 1 and 18 under 35 USC §102(b) as being anticipated by Matsumura (US Patent No. 5,862,447);
7. Rejected Claims 19-23 under 35 USC §102(b) as being unpatentable over Matsumura (US Patent No. 5,862,447) in view of Toyama et al. (US Patent No. 6,175,716);
8. Indicated that Claims 2-10, 12-13 and 15-17 are objected to as being dependent upon a rejected base claim, but that those claims would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims.

No further comment regarding items 1-5 above is deemed to be required in these Remarks.

With regard to item 6, the Examiner has rejected Claims 1 and 18 under 35 USC §102(b) as being anticipated by Matsumura (US Patent No. 5,862,447). Further, in item 8, the Examiner has rejected Claims 19-23 under 35 USC §102(b) as being unpatentable over Matsumura (US Patent No. 5,862,447) in view of Toyama et al. (US Patent No. 6,175,716). Applicants respectfully submit that since Claims 1 and 18 are the only independent claims present in this application, the patentability of the remaining claims will be carried thereby to the extent that the Examiner has not indicated that the subject matter thereof is not itself patentable. Further, since Claim 18 is the method associated with the apparatus of Claim 1, the patentability of Claim 18 will be established if Claim 1 is found to be patentable.

Applicants' review of the Examiner's present substantive rejections of the claims of this application, his response to Applicant's previous arguments and the Matsumura reference indicates that the Examiner in the currently outstanding FINAL Official Action has taken the position that a forward paper edge directed from a transport means as herein claimed "*toward*" an image forming means constitutes transporting that forward paper edge "*toward*" the transfer roller, at least in the broadest sense of the language currently utilized in Claims 1 and 18. In other words, the Examiner's comments indicate to the Applicants that Claims 1 and 18 do not sufficiently define the fact that in the present invention the forward edge of the paper is transported *toward the transfer roller 57 as opposed to being directed either directly into the nip or toward the image carrier 13*. In view of this, Applicants by the foregoing Amendment are proposing that Claims 1 and 18 be amended for clarity and specifically so as to recite that the sheets of paper are:

“...transported from at least one of the paper transport means toward a location relative to the rotating surface of at least one of the transfer means positioned substantially adjacent to the upstream end of the first nip or nips associated with the at least one of the transfer means”.

In other words, the forward edge of the transported paper sheet is directed toward a position associated with the rotating transfer means located close to the upstream end of the first nip. This new wording is believed to clarify the metes and bounds of the previous wording of Claims 1 and 18 in accordance with the present specification's description of the present invention.

Applicants respectfully submit that the foregoing amendment does not add any new matter to this application, and further that since it simply clarifies the meaning of the previously used word “toward” the independent claims, it does not present any subject matter that would require further consideration and/or search by the Examiner. Hence, entry of the foregoing amendment under 37 CFR 1.116 is believed to be appropriate in the circumstances of this application as placing the application in condition for allowance, or at least better form for Appeal, as required by 37 CFR 1.116. A decision so holding is respectfully requested in response to this communication.

More particularly, Applicants respectfully submit, as was submitted in their previous Amendment in this case, that the Matsumura reference nowhere specifies (or suggests) that paper sheets passing through the device therein shown are to be directed into the nip between the image carrier 13 at Q₃ and the transfer roller 57 such that the forward edges thereof are directed *toward the transfer roller 57 as opposed to being directed either directly into the nip or toward the image carrier 13*.

Applicants recognize that the Matsumura reference discloses members that might be said to correspond to “the image carrier”, “the transfer means” and “the paper transport means” as recited in Claim 1 of this application. Thus, as shown in Fig. 2 of the Matsumura reference, the image carrier 13 disclosed might be said to correspond to the image carrier herein claimed. Similarly, the transfer member 57 disclosed by Matsumura might be said to correspond to the presently claimed transfer means, and the sheet conveyor rollers 28 might be said to correspond to the paper transport means herein claimed. Also, it is to be noted with respect to the location of the “image carrier 13”, the “transfer member 57” and the “sheet conveyor rollers 28” in the Matsumura reference that while the sheet reverse unit 64 (Fig. 2) is disposed along one side of a line tangent to the nip formed between the image carrier 13 and the transfer member 57, none of the roller pairs (generally indicated at 66) within the reversing unit 64 is positioned to discharge a forward edge of a paper sheet toward the transfer member 57, the image carrier 13 or for that matter toward the nip formed between those elements.

Hence, it will be understood that the elements disclosed by the Matsumura reference are disposed relative to one another in a different manner than the corresponding elements are disposed relative to one another in the present invention. In addition, Applicants respectfully submit that as generally indicated above, a review of the Matsumura reference makes it abundantly clear that the sheet reverse unit 64 disclosed by the Matsumura reference is not the same thing as, and does not in any way correspond to, the paper transport means herein claimed. Instead, as mentioned above, the elements of the Matsumura reference that correspond to the paper transport means of the present application are the Matsumura sheet conveyor rollers 28. Consequently, while Applicants agree (1) that the Matsumura reference discloses paper transport roller pairs located on the image carrier side of a plane more or less tangent to the nip between the image carrier 13 and the transfer roller 57 (see primarily roller pair 28 immediately below the nip between image carrier 13 and transfer roller 57 in Fig. 2 of Matsumura, but not roller pairs 66 located within reverse unit 64 as alleged by the Examiner), and (2) that those roller pairs might be broadly construed as being in the transport path of the paper.

However, Applicant cannot agree that the Matsumura reference discloses, teaches or suggests that paper sheets fed to the image transfer location (i.e., nip) between the image carrier 13 and the transfer roller 57 by the roller pair 28 located immediately below the transfer location in Matsumura's Fig. 2 are directed toward the transfer means (i.e., in the context of Claim 1 of this application, the transfer roller 57) as opposed to being directed either directly into the nip or toward the image carrier 13.

As previously argued, Applicants respectfully submit that the foregoing position is clearly supported when an approximation of the plane more or less tangent to the nip between the pressure rollers of the roller pair 28 immediately below the image transfer location (the nip between the transfer roller 57 and the image carrier 13) in Matsumura's Fig. 2 is considered. Further, Applicants respectfully submit that the construction of the Matsumura reference as it relates to the present invention as herein claimed also is clear when an approximation of the directions at which paper is fed to the roller pair 28 just mentioned from the paper pathways extending upwardly from the various paper trays is considered (i.e., a direction toward the image carrier as in the prior art discussed in the background section of this application).

Consequently, Applicant respectfully submits that when the foregoing clarifying amendment is taken into account along with the fact that the paper reverse unit 64 is in no way equivalent, or a corresponding element, to the presently claimed paper transport means, the lack of any anticipation of the present invention by and/or obviousness of the present invention in view of the Matsumura reference is readily apparent. In other words, as clarified hereinabove, the claims of this application are not “anticipated” because each and every element of the claimed invention is not found in a single prior art reference arranged and cooperating with each other in the manner claimed.


Further, when the clarification provided by the foregoing amendment is taken into account, Applicants respectfully submit that the Examiner previous *prima facie* case in support of the unpatentability of certain of the claims of this application is no longer reasonably or arguably supportable. Specifically, all of the limitations of the claims of this application as hereinabove amended are not present in the prior art taken as a whole. In addition, there is no support in the currently cited and applied references of any teaching, disclosure or suggestion within the “four corners” of that art that in any way would lead one skilled in the art (absent reference to the present disclosure) to make the combination of elements now clearly and distinctly claimed.

Accordingly, Applicants respectfully submit that in the event that the foregoing clarifying Amendment is granted entry by the Examiner, the Examiner’s apparent previous construction of the language of the claims of this application as being broad enough to cover any direction of the forward edges of a sheet of paper generally toward the nip between the transfer means and the image carrier will no longer be valid. As a result, Applicants respectfully submit that the foregoing Amendment, if granted entry, overcomes all of the Examiner’s objections/rejections of the present application. Therefore, a decision granting the entry of the foregoing Amendment and reconsideration in view thereof are respectfully requested on the grounds that the foregoing Amendment would place the claims of this application in condition for allowance, or at least better form for Appeal, as required by 37 CFR 1.116 without requiring undue further consideration and/or search by the Examiner.

Applicants also believe that additional fees beyond those submitted herewith are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. 04-1105, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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SIGNATURE OF PRACTITIONER

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